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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,394	02/15/2001	Marc Eller	12179-P081P1	2998

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EXAMINER

SALCE, JASON P

ART UNIT PAPER NUMBER

2611

DATE MAILED: 07/20/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/784,394

Applicant(s)

ELLER ET AL.

Examiner

Jason P Salce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,6 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 5,6 and 14-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Response to Arguments

1. In view of the appeal brief filed on 4/9/04, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

After review of the applicant's arguments, the examiner agrees that Carney does not teach a digital cable television network. However, the examiner notes that since Carney does not teach a digital cable television network, and in accordance with the applicant's arguments, nor does the applicant's provisional application, therefore, applicant still does not attain the priority date set forth by the provisional application, and a new grounds of rejection under U.S.C 103 is provided, which supports the limitation of a digital cable television network.

The examiner recommends that if the applicant wishes to invoke the provisional priority date, to amend the claims in accordance with the amendment dated 1/20/2004 (after the first Advisory Action was mailed).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carney et al. (U.S. Patent No. 6,408,278) in view of Rhoads (U.S. Patent No. 6,411,725).

Referring to claim 14, Carney discloses providing a first electronic billboard at a first location (see element 14a in Figure 3 and Column 5, Lines 26-29).

Carney also discloses coupling a first information handling system to the first electronic billboard (see element 24a in Figure 3) so that the first information handling system can control information to be displayed on the first electronic billboard (Column 3, Lines 57-67).

Carney also discloses providing a second electronic billboard at a second location (see element 14n in Figure 3 and Column 5, Lines 26-29).

Carney also discloses coupling a second information handling system to the second electronic billboard (see element 24n in Figure 3) so that the second information handling system can control information to be displayed on the second electronic billboard (Column 3, Lines 57-67).

Carney also discloses coupling the first and second information handling systems to a third information handling system over a network (see element 20 in Figure 3 and Column 3, Line 6).

Carney also discloses selecting, via the third information handling system, which of the first and second electronic billboards will display the information (Column 3, Lines 55-67).

Carney also discloses uploading the information from the third information handling system (Column 3, Lines 59-63) over the Internet (Column 5, Lines 40-42) to the information handling system controlling the selected electronic billboard (Column 5, Lines 37-40).

Carney also discloses displaying the information on the selected electronic billboard (Column 3, Lines 65-67 and Column 5, Lines 26-29).

Carney discloses various types of networks for transmitting the video, but fails to disclose a digital television broadcast network. Rhoads discloses a digital television broadcast network for transmitting video to a billboard (see Column 12, Lines 44-56 and Column 19, Lines 26-30).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the network for transmitting video to the billboards, as taught by Carney, using the digital television broadcast network for transmitting video to billboards, as taught by Rhoads, for the purpose of providing higher quality television signals, which can be used to entice a user to view the billboard, as well as enable a

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system to use the existing cable system already deployed by the different cable companies, thereby minimizing the cost of the system.

Referring to claim 5, where Rhoads teaches a television transmitter for transmitting the billboard information to the billboard in a wireless manner (see Column 12, Line 47 for a satellite broadcast).

Claim 6 corresponds to claim 5, with the additional limitation of providing a multiplexer. Carney and Rhodes fail to disclose a multiplexer. The examiner takes Official notice that a multiplexer is well known in a satellite television distribution system. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the satellite broadcast system of Carney and Rhoads, to utilize a multiplexer, for the purpose of compacting various television signals provided from different broadcasters into one 6 Mhz channel for a more efficient transmission method.

Referring to claim 19, see rejection of claim 14.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 15-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carney et al. in view of Rhoads (U.S. Patent No. 6,411,725) in further view of Hunter (U.S. Patent No. 6,430,605).

Referring to claim 15, Carney and Rhoads teach all of the limitation in claim 14, but fails to teach a time period for displaying information on the billboard and displaying the information for the specified time period.

Hunter teaches selecting advertisements on a billboard at a selected time period (Column 8, Lines 57-67), and displaying an advertisements for the selected period of time (Column 9, Lines 15-18).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the server (third information handling system), as taught by Carney and Rhoads, using the option to specific a time period for displaying programming content, as taught by Hunter, for the purpose of alerting the users of "sale" items that are only available for a specified limited time (Column 2, Lines 47-52 of Hunter).

Referring to claim 16, Carney teaches all of the limitations in claim 14, but fails to teach the additional limitation of choosing the first and second billboard to receive information from a list of billboards.

Hunter teaches selecting which roadway-adjacent billboards to display programming content (Column 8, Lines 63-67).

At the time the invention was made, it would have been obvious to modify the server, as taught by Carney and Rhoads, using the option to allow the advertiser to choose which billboard to displaying information from a list, as taught by Hunter, for the purpose of allowing an advertise to only choose to display programming content where a high traffic volume is known (Column 2, Lines 25-30 of Hunter).

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Claim 17 corresponds to claim 16, with the additional limitation of the list including a map of the first and second locations. Hunter teaches that a map can provide the location and directions to a company's local stores (Column 9, Lines 2-5).

Claim 18 corresponds to claim 16, with the additional limitation of charging an amount of money for the display of the information on the selected electronic billboard. Hunter teaches a module 190 for producing bills for charging an advertiser (Column 5, Lines 32-34).

Referring to claim 20, see rejection of claim 15.

Conclusion


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P Salce whose telephone number is (703) 305-1824. The examiner can normally be reached on M-Th 8am-6pm (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 29, 2004



VIVEK SRIVASTAVA
PRIMARY EXAMINER